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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/745,509	11/12/1996	MICHAEL S. FELD	NLI-001AX	6390
207 7590 01/29/2009 WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109				
EXAMINER SMITH, RUTH S				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
01/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/745,509

Applicant(s)

FELD ET AL.

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29, 30, 32, 33, 36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29, 30, 32, 33, 36 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 21, 2008 has been entered.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-30,32,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfano et al (5,293,872) in view of Lewis et al, and Ito or Nagasaki et al. Alfano et al disclose the basic teaching of using a Raman endoscope as a diagnostic tool in examining tissue in vivo. Alfano et al discloses the use of a Nd:YAG laser to excite the tissue. Alfano et al also disclose the use of a broad band light source in order to provide a visible image of the tissue. Alfano et al fail to disclose the use of a sensor array, lens and filter all being positioned on the distal end of the endoscope. Lewis et al disclose a spectroscopic imaging device that includes a lens, a filter and a two-dimensional imaging sensor such as a focal plane array detector. The invention of Lewis et al relates to non-invasively collecting images at multiple discrete wavelengths in the visible, infrared or near-infrared region. The device of Lewis et al is applicable to biological materials. Lewis et al disclose forming a plurality of images at different infrared wavelengths as seen in column 12. Lewis et al specifically refers to the use of the spectroscopic imaging device in a microscope but states in column 16 that the invention can be applied to other traditional absorption or emission spectroscopic

approaches. Column 13 of Lewis et al disclose the application of the device to Raman Imaging/spectroscopy. Therefore, it would have been obvious to one skilled in the art to have modified Alfano et al such that the detector used is a two-dimensional imaging sensor such as a focal plane array in order to yield predictable results to one skilled in the art at the time of the invention such as improved spectral and spatial resolution. Furthermore, it should be noted that it is a well known expedient in the art to place an imaging sensor at the distal end of the endoscope rather than using an optical fiber to transmit the detected radiation to an image sensor. Examples of such are shown in Ito and Nagasaki et al. It would have been obvious to one skilled in the art to have further modified Alfano et al such that the focal plane array sensor is placed at the distal end of the endoscope. The advantage of such is to prevent the quality of pictures from deteriorating due to the breaking of optical fibers. Furthermore, it would have been obvious to one skilled in the art to have placed an optical filter in front of the imaging sensor in order to detect Raman scattered radiation at the desired wavelengths as disclosed by Lewis et al.

Claims 36,38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfano et al (5,293,872) in view of Lewis et al, and Ito or Nagasaki et al as applied to claim 29 above, and further in view of Janes et al. Janes is just one example of many which disclose an optical method of analyzing tissue which includes determining concentrations of a plurality of tissue components. In the absence of any showing of criticality, the specific manner in which the amount of a component of the tissue is determined and the specific component determined would have been an obvious design choice of known equivalents in the art. It would have been obvious to one skilled in the art to have further modified the method of Alfano et al such that it includes determining the amount of a plurality of tissue components such as by concentration or percentage. The advantage of such is to provide a more complete analysis of the tissue being evaluated.

Response to Arguments

Applicant's arguments filed October 21, 2008 have been fully considered but they are not persuasive.

It should be noted that claim 29 has a status identifier of "Currently Amended", however, the claim does not appear to have been amended.

It would have been obvious to one skilled in the art at the time of the invention to have modified Alfano et al such that the detector used is replaced with another well known type of detector in the art and these optical elements are placed at the distal end of the endoscope to yield predictable results such as to prevent the quality of pictures from deteriorating due to the breaking of optical fibers and improved spectral and spatial resolution.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ruth S. Smith/
Primary Examiner, Art Unit 3737

RSS